

Serial No.: 10/579,263
Examiner: Binta M. Robinson
Date of Office Action: 29 July 2010
Applicant(s): Widmer *et al.*
Date of Response: November 29, 2010

REMARKS

In a non-final Office Action mailed July 29, 2010, the Examiner correctly stated the status of the claims -- Claims 1-17 are pending, Claim 9-17 are withdrawn, and Claim 1-8 stand rejected for alleged indefiniteness and lack of enablement. Applicants traverse these rejections in turn below.

In the Claims

Claims 1, 9, 13, and 17 are amended. Claim 10 is canceled.

Claim 1 clarifies that the compound claimed comprises a bis-cation and an anion.

In Claims 9 and 13, the compound administered is an effective amount of at least one compound according to Claim 1.

In Claim 17, the microbial cells are contacted with a compound according to Claim 1.

No new matter is added.

Claim Rejections Under 35 U.S.C. § 112, second paragraph

The claims are rejected for alleged failure to particularly point out and distinctly claim the subject matter that Applicants regard as the invention. Specifically, the Examiner alleged that it is not clear if the bis-cationic compound of Claim 1 only consists of the bi-cation and no anion. Without agreeing to the Examiner's characterization of the claims, and solely to move this case to allowance, Applicants here amend Claim 1 to clarify that the bis-cationic compounds of the invention are not cations in isolation. As amended, Claim 1 recites a bis-cationic compound comprising a bis-cation and an anion. Support for this amendment can be found throughout the specification (for example at page 3, line 9) wherein salts of the bis-cationic compound of the invention are claimed. A skilled artisan understands that a salt must comprise both a cation and an anion. Accordingly, Applicants submit that this rejection is overcome and request its withdrawal.

Serial No.: 10/579,263
Examiner: Binta M. Robinson
Date of Office Action: 29 July 2010
Applicant(s): Widmer *et al.*
Date of Response: November 29, 2010

Claim Rejections Under 35 U.S.C. § 112, first paragraph

Claims 1-8 also stand rejected for allegedly lacking enablement. Specifically, the Examiner alleged that because the specification, while being enabling for making and using salts of the bis-cationic compounds of formula 1, does not reasonably provide enablement for making and using the bis-cationic compounds of formula 1 that do not contain anions. Without agreeing to the Examiner's characterization of the claims, and solely to move this case to allowance, Applicants here amend Claim 1 to clarify that the explicit exclusions of the proviso at the end of the claim are directed to the bis-cation of the compound and not the compound per se. As amended, the proviso at the end of Claim 1 recites "provided that the bis-cation of Formula (I) is not selected from the following." As the Examiner acknowledged on page 3 of the Office Action, the specification is enabling for making and using salts of the bis-cationic compounds of Formula I. Accordingly, Applicants submit that this rejection is overcome and request its withdrawal.

Claims 2-8 depend on Claim 1 thus Applicants submit that these claims are definite and enabled in light of the amendments.

Request for Rejoinder

In response to an Office Action mailed August 13, 2009 imposing restriction requirements under 35 U.S.C. § 121, the Applicants elected product claims drawn to bis-cationic compounds. Based on the claim amendments above, Applicants respectfully request rejoinder into the application of withdrawn Claims 9-17, drawn to methods of using the compounds according to Claim 1. During prosecution of the elected claims, the Examiner pointed to no citation that disclosed the methods recited in Claims 9-17. Moreover, the compounds employed in Claims 9-17 are fully consistent with the recitations of Claim 1. Support for these amendment is provided at least in paragraphs [0067-0068] of the specification wherein methods comprising administering an effective amount of at least one compound of Formula I or Formula II are disclosed. The claims embrace those compounds of Formula I, and use of those compounds, as set forth in Claim 1.

Serial No.: 10/579,263
Examiner: Binta M. Robinson
Date of Office Action: 29 July 2010
Applicant(s): Widmer *et al.*
Date of Response: November 29, 2010

In view of the amendments above and remarks below, Applicants respectfully request reconsideration of the merits of this patent application.

Fees

A petition for a one month extension of time accompanies this response so the response will be deemed to have been timely filed. Please charge the fee to Deposit Account No. 17-0055. Should any other fee be due in connection with this or any subsequent response, please charge the fee to the same Deposit Account.

Respectfully submitted,



Bennett J. Berson
Reg. No. 37,094
Attorney for Applicants
QUARLES & BRADY LLP
P O Box 2113
Madison, WI 53701-2113
TEL 608/251-5000
FAX 608/251-9166